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OFFICE OF PETITIONS

In re Application of :
Milstein et al :
Application No. 10/506,906 : DECISION ON PETITION
Filed: May 31, 2005 :
Attorney Docket No. DYC0101PUSA :

This is a decision on the petition under 37 CFR 1.182, filed, October 11, 2007, to remove the special status accorded this application on December 21, 2006, and to vacate a restriction requirement mailed October 9, 2007.

The petition to remove special status is **DISMISSED**.

The petition to vacate the restriction requirement is **DISMISSED** as being premature.

On August 24, 2006, applicant filed a petition under 37 CFR 1.102(d) to make special based on the application being directed to developing treatments and cures for HIV/AIDS or cancer as set forth in M.P.E.P § 708.02, Section X. The petition included statements concerning the contribution of the instant invention to the treatment of HIV/AIDS and/or cancer. The required fee under 37 CFR 1.17(h) was received. The petition for special status was granted on December 21, 2006, and on October 5, 2007, the examiner assigned to the case issued a restriction requirement. Petitioner now seeks to have the special status withdrawn and the restriction vacated.

In view of the importance of developing treatments and cures for HIV/AIDS and cancer and the desirability of prompt disclosure of advances made in these fields, the U.S. Patent and Trademark Office grants "special" status to patent applications related to HIV/AIDS and cancer. Applications made special by way of petition are advanced out of turn for examination. Subject alone to diligent prosecution by the applicant, the application must continue to be special throughout its entire prosecution in the U.S. Patent and Trademark, including appeal to the Board of Patent Appeals and Interferences. See M.P.E.P. 708.01(B). Hence the special status will not be removed. The petitioner may wish to consider filing a continuation since the special status would not be present in a continuing application, absent a petition being filed.

Petitioner also requests that the Office of Petitions vacate the restriction required by the examiner on October 9, 2007.

37 CFR 1.143 provides that if applicant disagrees with a requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefore. If the requirement is repeated and made final then applicants may petition under 37 CFR 1.144. A review of the file indicates that petitioner has not complied with 37 CFR 1.143 by requesting reconsideration with reasons against the restriction. Petitioner has not placed on the record any reasons traversing the restriction given by the examiner. Petitioner has not requested reconsideration of the restriction requirement by the examiner. Furthermore, note that the restriction given has not been made final by the examiner. Therefore the request to vacate the restriction requirement is premature.

But in any event, here, 37 CFR 1.144 does not currently apply since a prerequisite to the grant of a petition to make special under 37 CFR 1.102, was applicants waiver of the right to traverse a restriction requirement. Applicant has provided the proper waiver to the office. See page 1, paragraph 2 of applicant's petition dated August 24, 2006, and M.P.E.P. 708.02 VIII (B). Therefore applicant cannot now, after receiving a restriction requirement from the examiner, withdraw the waiver, and then be permitted to traverse the restriction requirement. An application when granted special status remains special throughout the prosecution of the application. Accordingly the instant request cannot be granted.

The Associate Power of Attorney filed with the petition on August 28, 2007, was filed after June 25, 2004, the effective date of a rule change eliminating the Associate Power of Attorney practice (37 CFR 1.34(b) was eliminated). *See MPEP § 402.02 and Revision of Power of Attorney and Assignment Practice*, 69 Fed. Reg. 29865 (May 26, 2004); 1283 *Off. Gaz.* 148 (June 22, 2004). Although the paper has been placed in the file, the names of the patent practitioners listed on the Associate Power of Attorney have not been made of record.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Amy DeCloux (Reg. No. 34,380) appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that she is authorized to represent the particular party in whose behalf she acts. If, Amy DeCloux desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Amy DeCloux, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the

address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

As authorized, the \$400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to Thurman K. Page at (571) 272-0602.

All other inquiries concerning either the examination or status of the application should be directed to Technology Center 1600.

The application is being forwarded to the Technology Center Art Unit 1644 for action.



David Bucci
Petitions Examiner
Office of Petitions

cc:

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